

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/524,190

Applicant(s)

HOLM ET AL.

Examiner

Kailash C. Srivastava

Art Unit

1657

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1 and 3-10.
Claim(s) withdrawn from consideration: Not Applicable.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (See Continuation on next page).

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: PTO 892.

/JON P WEBER/
Supervisory Patent Examiner, Art Unit 1657

Continuation of 11, does NOT place the application in condition for allowance because: Applicants' arguments filed with the response of 24 June 2010 do not overcome the Obviousness rejection for the reasons stated below.

Applicants' arguments and comments filed with response on 06/24/2010 do not overcome the Art rejection for the reasons stated below.

In the Office Action mailed 29 April 2010, Claims 1-10 have been rejected under 35 U.S.C. §103(a) as obvious over the combined teachings from Kanai, et al (1983, U.S. Patent 4,386,159; IDS filed 02/11/2005) in view of Zhang et al. (US PGPB 20020102673), and further in view of Fischer et al (U.S. Patent 4,252,901).

In response to obviousness rejection supra, applicants argument is, "neither Kanai, Zhang, Fischer, nor the combination thereof teach or suggest a drying step". Applicants further argue, "Kanai teaches away from drying organic matter to a dry solids content of at least 70% by weight total solids (TS) and subsequently pelletizing the same as recited in amended Claim 1. Kanai instead describes a material being ground to a "juice like liquid" which is essential to the proper functioning of the Kanai process. In addition Kanai does not mention drying the material and does not give any indications to the person skilled in the art that drying the material would be beneficial for the digestion process".

Applicants are correct in stating, "Kanai instead describes a material being ground to a "juice like liquid" which is essential to the proper functioning of the Kanai process".

As is well illustrated in the art, however, a juice like composition contains 15-80% TS (e.g., Britannica Online Encyclopedia, <http://www.britannica.com/EBchecked/topic/130867/concentrate> 7/1/2010; Bell et al (U.S. Patent 5554410 A, Column 5, Lines 12-30, especially Lines 16-18). Furthermore, the Examiner re-iterates that drying any material to a solid content of any concentration is merely a matter of design choice and does not change said composition for its functionality. Drying step is known to one of skill in art (See, e.g., Fox et al., Page 706, Lines 8-23, especially, Lines 14-15 in FERMENTATION AND BIOCHEMICAL ENGINEERING HANDBOOK Principles, Process Design, and Equipment, Second Edition, Vogel et al (Eds.) 1997, NOYES PUBLICATIONS, Westwood, New Jersey, USA, Pages 706-733) because of following reasons:

- To reduce the cost of transport;
- To ensure a prolonged storage life (i.e., increases the shelf life of a composition); and
- To make a material more suitable for handling (i.e., facilitates transportation);

Please note, in Applicants' process, the final solids concentration of the organic matter for the digestion to biogas by anaerobic bacteria is a slurry made by mixing the dry, pelletized matter with a liquid to contain TS of 15-45% and the slurry present in the reactor has TS of 5-10% (e.g., Claim 8) - in other words after drying and pelletizing, water will be added back in before fermentation.

It follows from Applicants' claims that Applicants have also applied a "juice like" material in their instantly claimed process and drying step does not change the functionality of the dried material because as discussed supra, the pertinent art clearly establishes:

- (i) the juice like material contains 15-80% TS;
- (ii) drying of a composition is a process step of design choice and does not materially change said composition for its function.

Thus, the claimed invention in instantly presented Claims 1-10 is obvious over Examiner-cited prior art references as is substantiated from the teachings of supplementary references (i.e., U.S. Patent 5554410 A to Bell et al., and Fox et al., 1997) cited as exhibits to demonstrate that TS concentration in a liquid slurry and drying are art approved steps.

Please note, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art at the time the invention was made. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, the 35 U.S.C. §103 statute does not require that the prior art identically disclose or describe Applicants' invention but rather that no patent should be obtained if the subject matter as a whole would have been obvious to persons having ordinary skill in this art at the time the invention was made.

In response to applicants' arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants' arguments cited supra have been fully and carefully considered, but are not persuasive for the reasons of record at pages 6-8, items 18-20 of the Office Action mailed 15 October 2009 and at pages 3-6, items 10-12 of the Office Action mailed 29 April 2010 and for the additional reasons as discussed and explained in the preceding paragraphs. Therefore, rejection of Claims 1-10 under 35 U.S.C. §103(a) as obvious and unpatentable over the combined teachings from Kanai et al., in view of Zhang et al., and further in view of Fischer et al., in the Office Actions cited supra is maintained and adhered to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:00 A.M. to 5:30 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent

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